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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,008	07/02/2001	Melissa Rockenbach	ROC01-002P	1128
23635	7590	07/29/2005	EXAMINER	
MILORD & ASSOCIATES, P.C. 10880 WILSHIRE BOULEVARD SUITE 2070 LOS ANGELES, CA 90024			MYERS, ADAM C	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/897,008

Applicant(s)

ROCKENBACH, MELISSA

Examiner

Adam C. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is in response to the communication received May 9<sup>th</sup>, 2005.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 3, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by I) Wilton (1994), and II) Cook (1996).

Claims 1-3 and 14 were originally rejected under Honpo. In Honpo, a first member comprising chocolate acted as a base about which a second member, also being chocolate, was securely attached for decoration of said first member. In light of applicant's amendment, examiner draws reference to the additional prior art mentioned above. In both reference I and II, a confectionary display device is taught. The confectionary display comprises an edible first member not made of chocolate and at least an edible indicia that is received by the first member and maintained thereon in a secure manner such that said indicia is viewable by an intended recipient. In reference I, the first edible member is a cake or cupcake having been iced, so that the Icing Decorations depicted, being edible, may be maintained upon said first edible member. It is inherently known in the art that confectionaries known as cakes or cupcakes have a composition excluding chocolate. In reference II, The first edible member is a graham cracker "house," receiving ornamentation from indicia, as depicted in the Figure accompanying the method by which the graham cracker house is constructed. It is inherently well known that graham crackers have a composition not made of chocolate.

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The above art is thus found to be anticipatory of the amended claim 1, and it has been rejected thusly.

In regard to claim 2, the first member of references I and II is substantially rigid.

In regard to claim 3, the first member of references I and II is substantially planar.

In regard to claim 14, the claim is rejected for the reasons given above, and additionally the amendment to the claim is rejected on the grounds that both references I and II teach the retention of a plurality of edible indicia in a secure manner with means other than melted chocolate. In reference I, the indicia are known as "Icing Decorations," and it is thus inherent that icing, being of a composition not being melted chocolate, is used for the secured retention of the indicia to the substantially rigid first edible member mentioned above. In reference II, an icing is used as edible glue for secured retention of indicia to the substantially rigid first edible member.

The above comments have shown that devices anticipating the applicant's claimed invention, including the invention as claimed in the amended claims, have been public knowledge well in advance of the priority date of this application. The references are provided to further illustrate the point that a plurality of confectionary bases, indicia, and securing means have been known in the art.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ref. I and II in view of Schroeder (4,560,562), Newsteder (4,778,683), and Swiss Colony Christmas Gift Book (1982).

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ref. I and II in view of applicant's admission of the prior art.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 8 above, and further in view of Parents' Magazine (v.67, n.9, p. 161, 9/92-Ref W2), Wilton (1996 yearbook, p. 124-Ref U3), Int'l, New Product Report (15, 7/22/94, p.11-Ref W3), Int'l, New Product Report (22, 11/16/90, p. 5, 7-Ref X3), CMM Confectionary Manufacture & Mkt (27, 11, 11/90, p. 16-Ref U4), Nation's Business (v. 72, p. 49, 10/84-Ref U), Gorman's New Product News (v. 28, n. 1, p. 18-Ref W), Int'l Product Alert (v. 17, n. 15, 8/7/2000-Ref U2), Int'l Product Alert (12/5/90-Ref V2) and Palm Beach Post (12/21/95, p. 1 FN-Ref X2).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ref. I and II in view of Schroeder ('562), Newsteder ('683) and Swiss Colony, further in view of applicant's admission of the prior art for the reasons given above.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 15 above, and further in view of the references as applied in the rejection of claims 9-13 for the reasons given therein.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ref. I and II as applied to claim 14 above, and further in view of the references as applied in the rejection of claims 9-13 for the reasons given therein.

The disclosures of reference I and II as outlined above have provided grounds for a primary set of references illustrating well-known practices in the art, and as such, are substitutable for Honpo in the rejections presented in the previous office action. The rejections under 35 U.S.C. 103(a) would retain validity as arguments expressing obviousness with Ref I and II being the primary reference, given their similarity to the Honpo reference originally used. Again, Ref I and II illustrate another embodiment of confectionary display and indicia, in light of the amendments to the claims. Additionally, the plurality of indicia illustrated by Ref I and II provides motivation to one of ordinary skill in the art to have manipulated the primary reference in a manner disclosed by the limitations of claims 4-13 and 15-20.

#### ***Response to Arguments***

Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive. The basis of the arguments are; that the Honpo reference, being of chocolate composition, would not anticipate the applicant's invention; and that if such technology was well known at the time of the invention, it would have been implemented, in the sense of patentable material. In regard to the first remark, it has been illustrated above that a plurality of confectionary bases, indicia, and securing means have been implemented, all anticipating the applicant's claimed invention. In regard to the second remark, the prior art has illustrated that such technology has been implemented in many forms prior to the applicant's invention.

In regard to the combination of multiple references, the applicant appreciates it is the duty of the office to do a complete search of prior art to the best ability of the

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examiner. As such, the examiner may often find multiple disclosures within prior art that may render the claim as obvious. Such is the case in the previous action. For example, in the previous action, claims 4 and 8 were rejected as unpatentable over Honpo in view of Schroeder ('562), Newsteder ('683), and Swiss Colony Christmas. Each secondary reference is capable of showing the limitations being lacked by Honpo (that being a first edible member being one of a plurality of shapes), but the examiner includes all references as means for showing well-known technologies within the art.

In regard to applicant's arguments that the limitations presented in claims 5-7 are unobvious and allowable are not persuasive. As noted in the previous action, claims 5-7 present a technology that has been well known in the art, to such a degree that the applicant uses a reference to the confectionary "M&M's" to illustrate the preferred embodiment. Motivation is found in the base features of both the primary reference and the "M&M's" type candy being of a chocolate base with an edible confectionary being adhered to the surface. Both the chocolate ornamentation of Honpo and the candy shell of "M&M's" exhibit a visible aesthetic, and it is appreciated by the applicant that additional ornamentation may be placed upon ornamentation previously adhered to the face of the first edible member.

In regard to applicant's remarks of the rejection of claims 9-13, each rejected claim is fully described. The grouping of claims 10-12 is done because these three claims present similar limitations (a tackiness being disposed about one surface of the indicia), and they are thus rejected by the same art. In examiner's pursuit of a concise action, the claims were grouped, but rejection of said claims has been fully explained.

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Such is also the case for the rejection of claims 18-20. Each of the claims 18-20 present limitations to applicant's invention that had already provided with detailed rejections. Thus, the grouping was provided in favor of a more concise action.

In response to applicant's argument that the applicant's invention is unobvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the rejection and prior art presented, it has been shown multiple times that the technology of the applicant's invention is well known. Any combination or modification of the prior art would have been obvious to one of ordinary skill in the art due to the similarity of the confectionary references.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Myers whose telephone number is 571-272-6466. The examiner can normally be reached on Monday-Friday, 8am-4: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**KEITH HENDRICKS  
PRIMARY EXAMINER**